



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,093	12/28/2001	Royce D. Jordan JR.	010569	2219

45695 7590 08/11/2005

WITHERS & KEYS FOR BELL SOUTH
P. O. BOX 71355
MARIETTA, GA 30007-1355

EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT PAPER NUMBER

2157

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,093

Applicant(s)

JORDAN, ROYCE D.

Examiner

Hussein A. El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to amendment received on June 6, 2005. Claim 2 was canceled. Claims 1, 3, 6, 10, 14 and 18 were amended. Claims 1 and 3-21 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "it" in 8th line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Doganata et al., U.S. Patent No. 6,728,714 (referred to hereafter as Doganata).

As to claim 6, Doganata teaches a method for detecting and selectively preventing the forwarding of an electronic message after receipt by the recipient, wherein the electronic message has a unique message identifier, the method comprising:

coding the electronic message to indicate a request to prevent forwarding (see col. 4 lines 40-61, e-mail is sent with an identifier);

scanning the electronic message for a request to prevent forwarding (see col. 4 lines 40-61, e-mail is scanned for identifier);

storing the message identifier in a blacklist database whenever the request is found (see col. 2 lines 62-col. 3 lines 7, message identifier is stored in a database); and

blocking forwarding by the recipient of the electronic message that has been received by the recipient when the message identifier matches an entry in the blacklist database (see col. 4 lines 40-61, e-mail is deleted from the inbox).

As to claim 7, Doganata teaches the method of claim 6, wherein the electronic message includes a message body, and wherein scanning includes searching the message body for a request to prevent forwarding (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 8, Doganata teaches the method of claim 7, wherein the electronic message includes a message header, and wherein scanning includes searching the message header for a request to prevent forwarding (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 9, Doganata teaches the method of claim 8, further comprising:
selecting the electronic message in which to include the request to prevent forwarding
(see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 10, Doganata teaches a system for detecting and selectively
preventing the forwarding of an electronic message received by a recipient, wherein the
electronic message has a unique message identifier, the method comprising:
means for coding the electronic message to indicate a request to prevent forwarding;
means for scanning the electronic message for a request to prevent forwarding; means
for storing the message identifier in a blacklist database whenever the request is found;
and means for blocking forwarding by the recipient of the electronic message that has
been received by the recipient whenever the message identifier matches an entry in the
blacklist database (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 11, Doganata teaches the system of claim 10, wherein the electronic
message includes a message body, and wherein the means for scanning includes
searching the message body for a request to prevent forwarding (see col. 4 lines 40-61
and col. 2 lines 62-col. 3 lines 7).

As to claim 12, Doganata teaches the system of claim 11, wherein the electronic
message includes a message header, and wherein the means for scanning includes
searching the message header for a request to prevent forwarding (see col. 4 lines 40-
61 and col. 2 lines 62-col. 3 lines 7),

As to claim 13, Doganata teaches the system of claim 12, further comprising:
means for selecting the electronic message in which to include the request to prevent forwarding (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 14, Doganata teaches a computer-readable medium having stored thereon instructions which, when executed by a processor, cause the processor to perform the steps of: coding an electronic message to indicate a request to prevent forwarding scanning the electronic message for a request to prevent forwarding; storing the a message identifier in a blacklist database whenever the request is found; and blocking forwarding by a recipient of the electronic message once it has been received bar the recipient whenever the message identifier matches an entry in the blacklist database (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 15, Doganata teaches the medium of claim 14, wherein the electronic message includes a message body, and wherein scanning includes searching the message body for a request to prevent forwarding (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 16, Doganata teaches the medium of claim 15, wherein the electronic message includes a message header, and wherein scanning includes searching the message header for a request to prevent forwarding (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 17, Doganata teaches the medium of claim 1b, further comprising:
selecting the electronic message in which to include the request to prevent forwarding (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 18, Doganata teaches a computer readable medium containing instructions that when executed by a computer perform the acts of: receiving user input for preventing forwarding of one or more electronic mail messages being sent to a recipient; storing matching input in a blacklist database; and upon a subsequent attempt to forward one of the one or more received electronic mail messages by the recipient who has received the one or more electronic mail messages, referencing the user input relative to the matching input in the blacklist database and preventing forwarding by the recipient (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 19, Doganata teaches the computer readable medium of claim 18, wherein receiving user input comprises receiving user input included in the header of an electronic mail message being created at a client computer where the user input from the header is referenced upon an attempt to forward the electronic mail message (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 20, Doganata teaches the computer readable medium of claim 18, wherein receiving user input comprises offering an option for a user to select within a graphical user interface when generating an electronic mail message at a client computer, the option being for preventing forwarding of the electronic mail message where the user input to the graphical user interface is referenced upon an attempt to forward the electronic mail message (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 21, Doganata teaches the computer readable medium of claim 18, wherein receiving user input to prevent forwarding comprises configuring a gateway of a network that the one or more electronic mail messages pass through to prevent forwarding of the one or more electronic mail messages (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Doganata .

As to claim 1, Doganata teaches a system for detecting and selectively preventing the forwarding of an electronic message, wherein the message is sent by a sender and received by to a recipient, and wherein the message has a message body and a message header, the system comprising:

a gateway in communication with an electronic mail client; a message selection module wherein the message selection module allows the sender to purposely identify selected messages by including, message identifiers in the message body;

a message database in communication with the gateway for storing a first message identifier associated with the electronic message; and

a search module in communication with the message database for determining whether a second message identifier associated with a received electronic message is contained in the message database and, if the message database contains the second message identifier, preventing forwarding of the received message by the recipient (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

Doganata does not explicitly teach the limitation the gateway is a “wireless gateway”. However Ralston teaches a system and method for filtering e-mails using a wireless gateway. It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Doganata by using a wireless gateway as taught by Ralston because doing so would allow the user to use portable devices to communicate over the internet using wireless communication.

As to claim 3, Doganata teaches the system of claim 1, wherein the message selection module identifies selected messages by including dot commands in the message body (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 4, Doganata teaches the system of claim 3, wherein the message selection module identifies selected messages by including commands in the message header (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

As to claim 5, Doganata teaches the system of claim 4, wherein the gateway applies a set of default policies to the electronic message (see col. 4 lines 40-61 and col. 2 lines 62-col. 3 lines 7).

Response to Arguments

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

July 27, 2005


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100